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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/050,359	03/31/1998	DANA M. FOWLKES	FOWLKES-4B	6741

1444 7590 10/18/2002

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EXAMINER

PONNALURI, PADMASHRI

ART UNIT PAPER NUMBER

1639

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/050,359</b>	Applicant(s) <b>Fowlkes et al</b>
Examiner <b>Padmashri Ponnaluri</b>	Art Unit <b>1639</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Aug 5, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

4)  Claim(s) 22, 25-30, and 32-38 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 22, 25-30, and 32-38 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

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### **DETAILED ACTION**

**NOTE:** The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1639**.

1. A request for continued examination under 37 CAR 1.114, including the fee set forth in 37 CAR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CAR 1.114, and the fee set forth in 37 CAR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CAR 1.114. Applicant's submission filed on 3/14/02 has been entered.  
*(filed on 8/5/02)*
2. Applicants reply to the Notice to Comply with Sequence Rules has been fully considered and entered into the application.
3. Amendment A filed on 7/14/98 has not been entered into the application.
4. Amendment G, filed on 3/14/021 has been fully considered and entered into the application. Claim 31 has been canceled by amendment E, filed on 3/28/01; claims 21 and 23 have been canceled and new claims 31-38 have been added by the amendment C, filed on 5/24/00; claims 1-20 and 24 have been canceled and new claims 25-30 have been added by the amendment B, filed on 9/29/99.
5. Claims 22, 25-30, 32-38 are currently pending in this application.

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6. The pending claims 22, 25-30, 32-38 require the following Restriction/election for examination and search of the inventions. Examiner apologizes if this causes any inconvenience.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Andrew Wang, Supervisory Patent Examiner at [andrew.wang@uspto.gov](mailto:andrew.wang@uspto.gov) or 7(703)306-3217. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

*Election/Restriction*

7. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 27-29, 22, 25-26, 30, 38, drawn to a structured panel consisting of a plurality of biased combinatorial linear peptide libraries, each having **one and only one constant residue at a position fixed for all peptides in all libraries of said panel**, classified in class 436, subclass 518 or class 435, subclass DIG 35.

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II. Claims 32-37, drawn to a structured panel of biased combinatorial linear peptide libraries, all peptides of said panel being the same length, **each library having exactly two constant residue positions**, classified in class 436, subclass 518 or class 435, subclass DIG 35.

8. Inventions of group I and group II are independent and/or distinct from each other as being drawn to materially different compositions, differing in structure (i.e., one and only one constant residue or two constant residues), and the peptides in two libraries differ functionally. Thus, restriction between the groups is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Even though the groups are classified in the same class/subclass, this has no effect on the non-patent literature search. Different groups would require completely different searches in non-patent databases, and there is no exception that the searches would be co-extensive. Therefore, these do not create an undo search burden, and restriction for examination purposes as indicated is proper.

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10. This application contains claims directed to the following patentably distinct species of the claimed invention:

**If either group I or II is elected, applicants are requested to elect the length of the peptides in each library and define the position of the fixed positions and the amino acid sequence present in each library.**

The different compositions of groups I or II are independent and/or distinct each from the other, as being drawn to materially different peptide compositions, differing in structure, and function, thus election for examination purposes as indicated proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CAR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

#### **Further Restriction**

11. *Claims 22, 25-30, 32-38 are drawn to composition or structured panel of consisting of a plurality of peptide libraries, and the claims recite different combinations of individual peptide sequences; in the claims peptide sequences have either one or two amino acids constant and the length of the peptides is not given. For example the formula in claim 22 discloses that the fixed position is in the middle of  $(Xaa)_m$  and  $(Xaa)_n$ ; m and n do not differ by more than two; that is the value for m and n are "zero to infinite". (for example m, n is equal to zero and the fixed amino acid (R) differs ; m is 0, and n is 1, R is same; m is 1, and n is 0, R is same; m is 2 and n is 0, R is same; m is 0 and n is 2, R is same..... ....)*

*Additionally the peptide sequences in each library differ by the composition (i.e., the composition differs by different amino acid present at each position, and using 20 naturally*

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*occurring amino acids, the number of possible sequences would be  $20^n$  where n is the number of amino acids present in the peptide).*

*Thus, the number of possible variations of peptides present in the library is infinite.*

***Applicant is required to select one combination of peptide sequences (i.e., define one single value for m; single value for n and one or two specific fixed position amino acid or amino acids) in each library for examination.***

The claimed different compositions are independent and/or distinct each from the other, as being drawn to materially different peptide libraries, differing in structure, and function. A reference anticipating one would not render the others obvious absent ancillary art. Additionally, the above peptide library compositions require different and separately burdensome manual/computer bibliographic and classification searches in patent and literature databases; and have acquired a separate status in the art because of their recognized divergent subject matter, which makes restriction for examination purposes as indicated proper.

Applicant is required under 35 U.S.C. 121 to **elect a single invention** (i.e., single peptide library in which the length and the fixed positions of the peptide sequence are defined; and with specific amino acid or amino acids,) for prosecution on the merits to which the claims shall be restricted.

Applicant is advised that a reply to this requirement must include an identification of the invention that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.

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Should applicant traverse on the ground that the method inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the method inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**12. For this response to be complete and for search purposes, applicants should provide the chemical structure of elected compounds, wherein each specific formula substituents of each of the above identified elected species are defined either by picture, or by expressing the species in terms of the variables of the formula.**

13. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner is on *Increased Flex Schedule* and can normally be reached on Monday to Friday from 7.00 AM to 3.30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

P. Ponnaluri  
Patent Examiner  
Technology Center 1600  
Art Unit 1639  
11 October 2002



PADMASHRI PONNALURI  
PRIMARY EXAMINER



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: **P. Ponnaluri**

ART UNIT: **1627**

SERIAL NUMBER: 09/050,359

FAX/TELECOPIER NUMBER: (703) 308-4315

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COMMENTS: \_\_\_\_\_  
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